The opinion in support of the decision being entered today was
not written for publication and is not binding precedent of the
Board.

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
_____

Ex parte KEVIN S. BARKER
_____

Appeal No. 2001-2267
Application 08/828,687
_____

ON BRIEF
_____

Before JERRY SMITH, BARRETT, and RUGGIERO, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

    This is a decision on the appeal under 35 U.S.C. § 134 from

the examiner's rejection of claims 1-12, which constitute all the

claims in the application.

    The disclosed invention pertains to a method and apparatus

for interfacing, from a single computer, a plurality of

application programs that conform to a standard.

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Representative claim 1 is reproduced as follows:

1. A method of interfacing, from a single computer, a
plurality of application programs that conform to a standard,
comprising the steps of:

creating an abstract class with desired functions common to
the plurality of application programs wherein the abstract class
selectively provides code for the desired functions;

defining additional classes to contain data that is passed
to and from said desired functions; and

creating subclasses for each of the plurality of application
programs to implement said desired functions of said abstract
class wherein the subclasses selectively utilize code provided by
the abstract class or replace the code provided by the abstract
class.

The examiner relies on the following references:

Bigus   5,787,425   July 28, 1998
                                          (filed Oct. 01, 1996)

H. Carr et al. (Carr), "Compiling Distributed C++," IEEE
Proceeding, December 1993, pages 496-503.

The admitted prior art described in appellant's specification.

Claims 1-12 stand rejected under 35 U.S.C. § 103. As

evidence of obviousness the examiner offers the admitted prior

art in view of Carr with respect to claims 1, 3-5, 7-9, 11 and

12, and Bigus is added to this combination with respect to claims

2, 6 and 10.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-12. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth

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in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make

in the brief have not been considered and are deemed to be waived

by appellant [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 3-5, 7-9, 11

and 12 based on the admitted prior art and Carr. These claims

stand or fall together as a single group [brief, page 3], and we

will consider independent claim 1 as the representative claim for

this group. The examiner has indicated how he finds the

invention of claim 1 to be obvious over the teachings of the

admitted prior art and Carr [answer, pages 3-4]. Appellant

argues that the admitted prior art does not support the broad

assertions made by the examiner. Specifically, appellant argues

that he has not admitted that it is known to provide a common

interface to different applications but has stated only the

problem solved by the present invention. Appellant notes that

the gateway application described in the background of this

application is not the common interface but is the application

which conforms to the standard of the common interface.

Appellant also argues that Carr does not support the examiner's

findings with respect to it. Specifically, appellant argues that

the use of the term gateway in Carr does not mean that Carr

suggests anything about a common interface which may be used by

multiple applications on a single computer as claimed. Appellant

argues that the gateway of Carr relates to a distributed data

processing system, is not an abstract class and does not provide

a common interface which multiple applications may use.

Appellant also argues that Carr does not teach defining

additional classes to contain data that is passed to and from

said desired functions as claimed. Finally, appellant argues

that the proposed combination of references results only from a

hindsight reconstruction of the claimed invention. Specifically,

appellant argues that the only motivation for combining the

applied references is to solve the problem which is only

recognized by appellant in this application. Appellant argues

that the artisan would not look to a parallel processing

reference such as Carr to resolve a problem associated with a

single computer [brief, pages 4-13].

The examiner responds by noting that the gateway of the

admitted prior art is a common interface because it connects two

or more distinct mail systems. The examiner also responds that

the entire Carr reference is directed to implementing a gateway

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using DC++. The examiner notes that Carr teaches an additional

class in which data is passed to and from the desired functions.

Finally, the examiner responds that the admitted prior art

teaches the need for implementing a gateway/common interface, and

Carr teaches programming a gateway with DC++. The examiner

asserts that it would have been obvious to the artisan to apply

object-oriented programming to implement a gateway/common

interface based on the admitted prior art and Carr [answer, pages

5-9].

We will not sustain the examiner's rejection of

representative claim 1 or of any of the claims grouped therewith.

Although we do not agree with many of the arguments made by

appellant in the brief, we do find one of the arguments to be

sufficiently compelling to require that the rejection be

reversed. Specifically, the examiner's rejection relies on the

"admitted prior art" to provide a fundamental teaching in support

of the rejection. More particularly, the rejection relies on the

admitted prior art as teaching a common interface for two or more

applications and the problems associated with such a common

interface. The examiner relies on Carr to teach a solution to

the problem allegedly recognized by the admitted prior art.

We note that appellant's application does not refer to any

portion of the disclosed material as "prior art," but instead,

has a section of the specification labeled as "Background of the

Invention." This portion of the specification notes that there

are problems associated with interfacing several different

applications on a computer. This portion of the specification,

therefore, indicates that there is a need to create a standard

interface which allows two or more systems to be accessed at the

same time on the same machine and in which the program does not

need to be changed when later on additional programs are

developed that conform to standard or an enhanced version of the

standard [specification, pages 1-2]. We agree with appellant

that this indication that there were problems that the applicant

wished to solve does not constitute admitted prior art.

Appellant's brief states the following:

> The portion relied on from the present
> specification merely recites a realization on
> the part of the inventor that the problem
> solved by the present invention exists. The
> Final Official Action points to no "prior
> art" which even acknowledges this problem,
> other than Appellant's specification. The
> statement in the Background relied on by the
> examiner is not admitted prior art.
> Appellant does not state that it is
> conventionally known, in the art or
> otherwise, or provide any indication that the
> statement of the problem solved by the

> present invention was known in the art.
> While Appellant makes no representation as to
> whether the problem solved by the present
> invention was appreciated by others,
> Appellant submits that the Examiner cannot
> rely on such a statement as prior art or as
> motivation to combine prior art but must find
> such a teaching in a prior art reference
> [brief, pages 11-12].

The issue of whether the problem solved by appellant's invention

was known in the art could affect the patentability of the claims

before us. As noted above, we agree with appellant that the

specification by itself is not admitted prior art, and

appellant's argument in the brief must be taken as factual since

we presume that appellant would have filed an information

disclosure statement under the requirements of 37 CFR § 1.56 if

appellant was aware of relevant prior art with respect to this

particular issue. Therefore, as it stands, there is no evidence

on this record that the prior art appreciated the problem that

appellant's invention was designed to solve. The linchpin of the

examiner's rejection is that the artisan would have been

motivated to solve the problem identified by appellant in the

background section of the specification. Since the portion of

the specification relied on by the examiner is not admitted prior

art for reasons discussed above, the examiner's rejection

completely falls apart. There is no way that the claimed

invention is suggested by Carr taken alone.

We now consider the rejection of claims 2, 6 and 10 based on the teachings of the admitted prior art, Carr and Bigus. Since Bigus does not overcome the deficiencies of the admitted prior art, we do not sustain the rejection of these claims for the same reasons discussed above.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-12 is reversed.

<u>REVERSED</u>

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        JERRY SMITH                      )
        Administrative Patent Judge      )
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                                         ) BOARD OF PATENT
        LEE E. BARRETT                   )
        Administrative Patent Judge      )   APPEALS AND
                                         )
                                         ) INTERFERENCES
                                         )
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JS:pgc

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